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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/298,763	04/23/1999	RAHN WOOD		2415

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Kenyon & Kenyon  
ONE BROADWAY  
NEW YORK, NY 10004

EXAMINER
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CHAMPAGNE, DONALD

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 01/22/2004

22

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/298,763

**Applicant(s)**

WOOD ET AL.

**Examiner**

Donald L. Champagne

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 April 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other:  |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed with an amendment on 14 October 2003 have been fully considered but they are moot in view of the new basis for rejection.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 22 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the other claims, does not reasonably provide enablement for claim 22. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims. There is a logical conflict between claim 22 and its parent claim 20. Claim 20 is limited to "without pre-registration of the user", while claim 22 is limited to "a cookie that stores a user ID". "Registration" (or pre-registration) is the process of recording automatically (Merriam-Webster's Online Dictionary), which is what a cookie does. Hence the limitation to a cookie in claim 22 contradicts the limitation to no registration in claim 20.

### ***Claim Rejections - 35 USC § 102 and 35 USC § 103***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 5-13, 16-22, 24, 25, 32-35 and 38 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Jovicic et al.
7. Jovicic et al. teaches (independent claims 1, 17, 19, 20, 32 and 38) a computer-implemented method and system for interactively and electronically distributing and redeeming rewards, the method comprising: displaying a graphic of an electronic coupon, which reads on an advertising image, a reward indicator, and a promotional incentive for purchase transaction, on a computer screen of a local computer, wherein the local computer is coupled to a computer network (col. 4 lines 28-29), and enabling a user to select the image (col. 4 lines 19-20); at a central location coupled to the computer network, seamlessly determining the identity of the user (col. 2 lines 49-51) when said image is selected, and at the central location, automatically allocating a reward associated with the coupon/advertising image when said image is selected, wherein said allocating step includes storing a reward identifier associated with the identity of the user in a database, said reward indicator identifying the coupon, which reads on a promotional incentive.
8. Jovicic et al. also teaches: (claim 20) without pre-registration of a (new) user, where pre-registration is interpreted as registration before the present online session; (claim 32) the user storing and later redeeming coupons (col. 3 lines 11-15), which reads on the user computer enabling the user to select a reward for redemption from the list of rewards previously collected by the user and that are available for redemption;
9. Jovicic et al. does not explicitly teach optionally directing the local computer to a webpage associated with the image. However, under the principles of inherency (MPEP § 2112.02), since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the reference invention. As evidence tending to show inherency, it is noted that the user is inherently able to redirect the local computer to a website of the subject coupon product. Alternatively, because it is a convenient and obvious means for a user to obtain more information on a product for which a coupon is offered, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to

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add optionally directing the local computer to a webpage associated with the image to the teachings of Jovicic et al.

10. Jovicic et al. does not explicitly teach that the purpose of the method and system is increasing the click-through rate for advertisements/to attract traffic to a promoter computer. However, the method claimed is considered to be anticipated by the reference invention. As evidence tending to show inherency, it is noted that the purpose of all advertising is product promotion, of which targeted promotion distribution is an important element. Success is measured by the number of coupons that are selected and used, which reads on increasing the click-through rate for electronic coupons/advertisements or attracting traffic to the promoter computer.
11. Jovicic et al. also teaches at the citations given above claims 5-6, 25 and 33-36. The reference also teaches claims 7, 22, 24 and 35 (col. 3 line 27); claims 8-11 and 18 (col. 3 line 13 and col. 6 line 54); claim 12 (col. 6 line 51); claims 16 and 33 (col. 2 line 44); and claims 21 and 34 (col. 7 lines 12-14). The reference also teaches claim 13 inherently as the home page of the Internet Coupon Server (col. 6 lines 5-6).
12. Claims 2-4, 14-15, 23, 26-31, 36, 37 and 39 are rejected under 35 USC 103(a) as obvious over Jovicic et al.
13. Jovicic et al. does not teach (claims 2-4, 23 and 36) storing the user ID number in a cookie/local computer datafile. Because cookies were well-known user conveniences, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add storing the user ID number in a cookie/local computer datafile to the reference invention.
14. Jovicic et al. does not teach (claims 26-31) the user device limitations of these claims (ATM, PDA, etc.). However, the user does teach the genus *general-purpose digital computer* and a PC (col. 5 lines 26 and 41-42). Because the claimed devices were well known and convenient user computers, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add these user computers to the reference invention.
15. Jovicic et al. does not teach (claims 14-15) ID input by magnetic stripe or smart card. Because this is an inherent and convenient means for input with some of the obvious claimed user computers (e.g. ATM), it would have been inherent, or alternatively obvious to

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one of ordinary skill in the art, at the time of the invention, to input the ID by magnetic stripe or smart card.

16. Jovicic et al. does not teach (claims 37 and 39) means to transfer a reward to another registered user. Because this would be an attractive user feature easily implemented with the reference invention, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add means to transfer a coupon reward to another registered user to the teachings of Jovicic et al.

### ***Conclusion***

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
18. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 703-308-3331. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 703-746-5536.
20. The examiner's supervisor, Eric Stamber, can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5771.

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21. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that “disposal or clarification for appeal may be accomplished with only nominal further consideration” (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.
22. Applicant may have after final arguments considered and amendments entered by filing an RCE as appropriate. It is the examiner's practice to search the specification of RCE filings for allowable matter. However, unless indicated in this or a previous Office action, examiner cannot give assurances that filing an RCE will result in an indication of allowable matter. In this particular case, since applicant has once filed an RCE and examiner has once searched the specification for allowable matter, the prospects are not good that another RCE could be successful.
23. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, [www.uspto.gov](http://www.uspto.gov). At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.



Donald L. Champagne  
Examiner  
Art Unit 3622

13 January 2004